

Applicants : Tove Ringerike et al.
Serial No. : 10/577,268
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REMARKS

Claims 1-9, 11-13, 15-16, and 24 were pending in the subject application. By this Amendment applicants have amended claims 4, 8, 9, 12, 13, 15, 16, and 24, cancelled claims 1-3 and 5-7 without disclaimer or prejudice to applicants' right to pursue the subject matter of these claims in the future, and added new claims 44-52. Specifically, claims 4 and 8 have been amended so that they are in independent form, claim 9 has been amended to depend from claim 4, and claims 12, 13, 15, 16 and 24 have been amended to improve clarity.

Support for new the amendments to claims 4 and 8 and for new claims 44-45 can be found in the specification as filed at, *inter alia*, page 5, lines 6-29 and page 6, lines 1-14.

Support for the amendments to claims 9, 12, 13, 15, and 16 and for new claims 46-51 can be found in the specification as filed at, *inter alia*, page 6, lines 15-29, and page 7, lines 1-2.

Support for the amendments to claim 24 and for new claim 52 can be found in the specification as filed at, *inter alia*, page 7, lines 20-28.

Accordingly, applicants maintain that the amendments to the claims raise no issue of new matter.

Restriction Requirement

In the November 13, 2009 Office Action the Examiner acknowledged applicants' election of the Group I claims (claims 1-9, 11-13, and 15-16) and of the species: SEQ ID NO:10 (e.g. claims 4 and 8), EL4 T-cells (e.g. one type of cell line from claim 15), and the cell line EL/p1-5' IL2-dEGFP/6 (e.g. one type of cell line

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from claim 16). The Examiner stated that the election has been treated as an election without traverse and that claim 24 has been withdrawn from further consideration.

In response, applicants respectfully request rejoinder of claim 24 because claim 24 is a method of use of an elected product and contains all limitations of claim 9, which applicants believe is now in condition for allowance. M.P.E.P. §821.04(b).

Drawings

The Examiner objected to Figures 22-24, stating that the photos of Figure 22 are illegible and the text of Figures 23 and 24 is illegible.

In response, applicants submit corrected Figures 22-24 herewith as **Exhibits A-C**, respectively. Accordingly, applicants respectfully request reconsideration and withdrawal of the drawing objections.

Claims Rejected Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 1-9, 11-13, and 15-16 as allegedly indefinite.

Claims 1, 3, 5, and 7

The Examiner rejected claims 1, 3, 5, and 7 for reciting the term "originate from." The Examiner stated that it is not clear what is encompassed by the term "originate from" regarding a cytokine sequence to define the metes and bounds of the claim.

In response, applicants have hereinabove cancelled claims 1, 3, 5, and 7 without prejudice.

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Claims 2 and 6

The Examiner rejected claims 2 and 6 for reciting the broad limitation "a Green Fluorescent Protein (GFP)" along with the allegedly narrower limitation "possibly selected from its variants: d1EGFP, d2EGFP, EGFP, or EGFP-F."

In response, applicants have hereinabove cancelled claims 2 and 6 without prejudice.

Claim 12

The Examiner rejected claim 12 for reciting the broad limitation "an immortal mammalian cell line" along with the allegedly narrower limitation "preferentially descendant from."

In response, applicants have hereinabove amended the claim to remove the recitation of "preferentially descendant from cells of the immune system."

Claims 2, 4, 6, 8-9, 11-13, and 15-16

The Examiner rejected claims 2, 4, 6, 8-9, 11-13, and 15-16 as indefinite insofar as they depend from claims 1, 3, 5, and 7.

In response, applicants have hereinabove cancelled claims 2 and 6 without prejudice, rewritten claims 4 and 8 in independent form, and amended claim 9 to depend from claim 4. As amended, claims 4 and 8 do not recite "originate from," and claims 9, 11-13, and 15-16 depend directly or indirectly from claim 4. Accordingly, applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §112, second paragraph rejections of claims 4, 8-9, 11-13, and 15-16.

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Claims Rejected Under 35 U.S.C. §102

The Examiner rejected claims 1-3, 5-7, 9, 11-13, and 15 under 35 U.S.C. §102(b) as allegedly anticipated by Frazier et al. (US Patent Application Publication No. 2002/132290). The Examiner also rejected claims 1-3, 5-7, 9, 11-13, and 15 under 35 U.S.C. §102(e) as allegedly anticipated by Glimcher et al. (US Patent No. 7,393,944).

The Examiner stated that claim 1 reads on any isolated nucleic acid molecule coding a known reporter gene sequence and claim 5 reads on any expression vector containing a nucleic acid molecule coding a known reporter gene sequence because both of the base claims 1 and 5 encompass the embodiments wherein the promoter sequence and the 3'UTR sequence are absent.

The Examiner asserted that Frazer et al. teaches expression vector constructs containing an isolated nucleic acid molecule coding the expression box with the formula S_1 - S_2 - S_3 wherein S_1 is a promoter, S_2 is a GFP reporter gene, and S_3 is a regulatory 3'UTR sequence, where the promoter and 3'UTR sequences originate with a known cytokine gene and are the controlling sequences of the cytokine (e.g. paragraph 0003 and 0017). The Examiner also asserted that Frazer et al. contemplates using EL4 T-cell host cells (paragraph 0139, line 3), which meets the limitations of claims 1-3, 5-7, 9, 11-13 and 15.

The Examiner further asserted that Glimcher et al. teaches nucleic acid expression vectors containing recombinant/isolated IL-2 promoter sequence and GFP reporter sequence and that Glimcher et al. explicitly recites using EL4 T-cell host cells for expression of the constructs (e.g. Column 52, Example 7,

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lines 54-56 and Column 52, Example 7, lines 37-40) which meets the limitations of claims 1-3, 5-7, 9, 11-13, and 15.

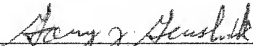
In response, applicants have hereinabove canceled claims 1-3 and 5-7 without prejudice, rewritten claim 8 in independent form, and amended claim 9 to depend from claim 4. By this Amendment, claims 9, 11-13, and 15 now depend directly or indirectly from claim 4, which was not rejected under 35 U.S.C. §102. Accordingly, applicants respectfully request reconsideration and withdrawal of the anticipation rejections of claims 9, 11-13, and 15.

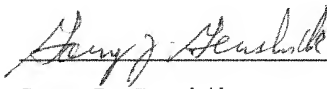
If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

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No fee, other than the \$65.00 fee for a one-month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

Certificate of Transmission	
I hereby certify that this correspondence is being transmitted via the Electronic Filing System (EFS) to the U.S. Patent and Trademark Office on <u>March 12, 2010</u> .	
 Gary J. Gershik Reg. No. 39,992	<u>3/12/10</u> Date


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